

Att'y. Docket No.
ISR 99-24 06



DA/S
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Todd M. BERTOCH et al.

Serial No. : 09/894,880

Examiner: LoAn H. Thanh

Filed : June 29, 2001

Group Art Unit: 3763

For : CATHETER SECURING DEVICE

PETITION UNDER 37 C.F.R. § 1.181

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Sir:

TECHNOLOGY CENTER R3700

A restriction requirement was mailed in the above referenced case on December 9, 2003. This restriction requirement indicated that claims 1-20 were subject to a restriction and/or election requirement. Specifically, the Examiner stated that the present application contains claims directed to the following patentably distinct species of the claimed invention: A/Figs. 1-4, B/Figs. 5-10 and C/Figs. 11-13b. Applicants are unsure of how the Examiner views Fig. 14, as it is not included in these groupings.

On January 9, 2004, Applicants submitted a response to the restriction requirement and elected Group I drawn to Figs. 1-4. Applicants stated that claims 1-4, 6, 7, 9-13 and 16-20 read on Figs. 1-4. In the response, Applicants also requested that the restriction requirement be withdrawn as being improper under MPEP §803 because the Examiner failed to provide any reasons and/or examples to support the restriction requirement.

An Office Action was mailed on March 25, 2004 indicating that the restriction requirement was proper because Applicants were given the reasons for the restriction requirement in paper number 13. The Examiner also stated that, "applicant has disclosed in the specification that the figures are of different embodiments."

According to MPEP §808, "every requirement to restrict has two aspects: (A) the reasons (as distinguished from the mere statement of conclusion) why the inventions as claimed are either independent or distinct; and (B) the reasons for insisting upon restriction therebetween as set forth in the following sections." Furthermore, MPEP

§816 requires that the particular reasons relied on by the examiner for holding that the inventions as claims are independent or distinct should be given, and provides that a mere statement of conclusion is inadequate. Applicants submit that the Examiner's statement that, "this application contains claims directed to the following patentably distinct species of the claimed invention ..." is a mere statement of conclusion and fails to provide any reasons why the inventions are distinct. Thus, the Examiner's restriction requirement was improper.


The Examiner asserts that the present application claims three distinct inventions, namely the devices illustrated in Figs. 1-4, 5-10 and 11-13b respectively. As stated in ¶ 0048, Figs. 1 and 5 illustrate possible and exemplary placements for the first peg 50 and the second peg 52 on the catheter securing device of the present invention. Figs. 2-3 illustrate different views of the device in Fig. 1. Fig 4 is a cross-sectional view of a portion of the guard 20 of the invention. Figs. 6-10 show different views of the device in Fig. 5. In addition, Figs. 3 and 9 show two different exemplary orientations for the wedge 30 of the catheter securing device (see ¶ 0047). Accordingly, the devices illustrated in Figs. 1-4 and 5-10 are clearly not independent inventions.

Figs. 11-13b illustrate alternative embodiments of the catheter securing device shown in Figs. 1-4 and 5-10. Referring to ¶ 0056, Fig. 11 is an alternative embodiment having two guards 20, 20' joined by either one or two wedges 30. Fig. 12 is a modification to this alternative embodiment, wherein the wedges 30 are replaced with columns 30' (see ¶ 0056). Figs. 13a and 13b illustrate another alternative embodiment of the catheter securing device, wherein the guard includes a member 28 extending between the posterior regions 24 (see ¶ 0058). Applicants submit that the embodiments shown in Figs. 11-13b are not inventions which are independent of the devices illustrated in Figs. 1-4 and 5-10. Furthermore, in the March 25, 2004 Office Action, the Examiner stated that a restriction requirement was proper because the specification discloses that the figures are of different embodiments. However, the Examiner defined one of the patentably distinct species of the claimed invention as Group C drawn to Figs. 11-13b. The specification clearly indicates that Figs. 11-13b illustrate more than one alternative embodiment of the present invention. Thus, the fact that different embodiments are disclosed in the figures cannot provide a sufficient reason for a restriction requirement.

In addition, MPEP §803 states that, "if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." By grouping Figs. 11-13b together as patentably distinct group, the Examiner has admitted that it would not be a burden to search and examine the present application if it includes alternative embodiments. As described above, Figs. 1-4, 5-10 and 11-13b illustrate closely related exemplary or alternative embodiments of the catheter securing device of the present invention. Thus, a search and examination of an application including claims describing the devices of Figs. 1-4, 5-10 and 11-13b would not create a serious burden.

For at least the reasons given above, Applicants respectfully request that the Examiner withdraw the restriction/election requirement and proceed on the merits for all of the original pending claims. The petition fee is being submitted in the concurrently filed Fee Transmittal. Applicants respectfully request the petition fee be refunded if the Petition is granted.

Respectfully submitted,
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